

REMARKS

Claims 1-7, 9-15 and 17-19 are currently pending. Claim 8 was canceled without prejudice. Claim 1 is amended to more distinctly claim what Applicant regards as the present invention and is supported by the specification and claims as originally filed. No subject matter has been relinquished by such amendments. Claims 18 and 19 are new. The Specification is amended to correct typographical errors in the reference numbers of the figures. Support for the amendment can be found in Figure 1. No new matter is added by way of these amendments. Applicant reserves the right to pursue these claims, prior versions of the claims, and/or the cancelled claims in another application.

The Examiner rejected claims 1-3, 5-9, 11-16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over International Publication WO 00/42274 to Shortland et al. ("Shortland") in view of U.S. Patent No. 5,043,839 to Wallace ("Wallace"). The Examiner rejected claims 4 and 10 under 35 U.S.C. § 103(a) as being obvious over Shortland in view of Wallace and further in view of U.S. Patent No. 5,063,251 to Bergishagen ("Bergishagen"). For the reasons detailed below, the rejections should be withdrawn, and the claims should be allowed to issue.

Applicant's Reply

In this Response, Applicant amends claim 1, adds new claims 18 and 19, and addresses the Examiner's rejections. Support for the amendments to the claims can be found throughout the application. Amendments to the claims are being made solely to expedite prosecution and do not constitute an acquiescence to any of the Examiner's rejections. Applicant's silence with regard to the Examiner's rejections of the dependent claims constitutes a recognition by the Applicant that the rejections are moot based on Applicant's Amendment and Remarks relative to the independent claim from which the dependent claims depend.

Rejection under 35 U.S.C. §103(a)

Claims 1-3, 5-9, and 11-16 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Wallace.

Amended, independent claim 1 is directed to a ventilating decorative floor covering for loose laying on an upper surface of a floor wherein the floor covering is a plastics floor covering. Among other things, the floor covering includes a “decorative upper surface and a lower surface on which are formed one or more studs so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor.” Neither Shortland nor Wallace, considered alone or in combination, disclose or suggest a decorative floor covering with this recited combination of elements.

To reject claims in an application under Section 103, an Examiner must establish a *prima facie* case of obviousness. Using the Supreme Court’s guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines “obviousness” as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int’l Co. v. Teleflex Inc.*, the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidly applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. *KSR*, 550 U.S. ___, 82 USPQ2d 1385, 1396 (2007)).

Importantly, the Court emphasized that a patent Examiner’s analysis under Section 103 must be

made explicit and there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Applicant respectfully submits that Examiner's analysis under Section 103 is not explicit and that the Examiner has not provided articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

Shortland and Wallace are directed to unrelated technical fields and there is no motivation for one of ordinary skill in the art to combine the two references. Shortland is directed to non-stain flooring. (*See* Shortland, Abstract). In contrast, Wallace is directed to controlling electrostatic charges. (*See* Wallace, Abstract). One of ordinary skill in the art would not look to a structure designed to control electrostatic charges to modify a non-stain flooring structure as described in Shortland, and there would be no expectation of success in making such a combination. Therefore, claim 1 is patentable over Shortland and Wallace for at least this reason.

Assuming, *arguendo*, that there was a reasonable expectation of success and a motivation to combine Shortland and Wallace, the combination still would fail to disclose or suggest all elements of claim 1 as amended, which recites a ventilating decorative floor covering wherein the floor covering is a plastics floor covering and including "a lower surface on which are formed one or more studs so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor."

As acknowledged by the Examiner in the Office Action, Shortland does not disclose one or more studs formed on the lower surface of the floor covering. (*See* Office Action, page 2). The Examiner, however, believes it would have been obvious for one of ordinary skill in the art to modify the floor covering described in Shortland to include the teaching of Wallace and that this combination renders obvious claim 1. (*See* Office Action, page

2). Applicant respectfully disagrees.

Wallace is directed to an electrostatic discharge floor structure. The structure has layers comprising cushion tiles, strips of conductive tape, a layer of conductive epoxy, and semiconductive tiles. (See Wallace, col. 3, lines 13-18). As described in Wallace, the advantages obtained by the floor structure described in Wallace are due to the combination of described features, and a skilled person would have understood from Wallace that all of its features were essential to the described invention. Therefore, Wallace teaches away from Applicant's claim 1 because it requires a conductive tape, in the form of a copper foil tape or a metal screen or mesh. (See Wallace, col. 5, lines 35-53). Accordingly, when combining the teachings of Shortland with those of Wallace, the resultant floor covering would necessarily include the metal conductive tape. As amended, claim 1 recites "[a] ventilating decorative floor covering for loose laying on an upper surface of a floor wherein the floor covering is a *plastics floor covering*." (Emphasis added). Therefore, the combination of Shortland and Wallace does not disclose or suggest a plastics floor covering because it includes metal conductive tape. Accordingly, claim 1 is patentable over Shortland and Wallace, either alone or in combination.

Additionally, Shortland and Wallace, either alone or in combination, do not disclose an arrangement "so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor *sufficient to ventilate the floor*." (Emphasis added). As admitted by the Examiner, Shortland does not disclose any studs on the lower surface and therefore also does not disclose any air gap. Wallace discloses that conductive foam material 50 is placed under the planar body 22 of modular cushion tiles 16 in the space between support members 24. (See Wallace, col. 6, lines 62-65). The Examiner acknowledges the use of conductive foam material in Wallace but takes the position that only a minimum amount of conductive foam material is necessary to detect moisture and that that an air gap between the

floor surface and floor covering is maintained in Wallace. (See Office Action, page 5).

Assuming, *arguendo*, that this is the case, Wallace still fails to disclose or suggest an air gap “between the lower surface of the floor covering and the upper surface of the floor *sufficient to ventilate the floor*” as recited in claim 1. Instead, Wallace uses a moisture detector circuit and a blower circuit to remove excess moisture. (See Wallace, col. 8, lines 19-60; col. 9, lines 35-50). The support structure described in Wallace does not provide an air gap sufficient to ventilate the floor as recited in claim 1 because an additional blowers and circuitry are required to remove moisture. Therefore, Wallace does not disclose or suggest an air gap between the lower surface of the floor covering “so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor *sufficient to ventilate the floor*” as recited in claim 1. Therefore, claim 1 is patentable over Shortland and Wallace, either alone or in combination, for at least this additional reason.

Since claim 1 is allowable, claims 2-3, 5-7, 9, and 11-14 depending therefrom are also allowable.

Independent claim 15 is directed to a method of laying a floor covering as defined in claim 1. Therefore, claim 15 is patentable over the cited art for at least the same reasons as discussed above with respect to claim 1.

Since claim 15 is allowable, claim 17 depending therefrom is also allowable.

Claim 16 was previously cancelled, and therefore the rejection of this claim in moot.

Claims 4 and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Shortland in view of Wallace and further in view of Bergishagen.

Claims 4 and 10 depend from claim 1 and thereby incorporate all of the limitations of claim 1. As discussed above, Shortland and Wallace, either alone or in

combination, fail to disclose or suggest every element of claim 1. Bergishagen has only been cited as describing a blowing agent and therefore does not cure the deficiencies of Shortland and Wallace in this regard. Therefore claims 4 and 10, depending from claim 1, are allowable for at least the same reasons discussed above for claim 1.

New, independent claims 18 and 19 include analogous features to independent claim 1. Therefore, claims 18 and 19 are allowable for at least the same reasons discussed above with respect to claim 1.

Additionally, independent claim 19 is directed to a ventilating decorative floor covering including, among other things, "the lower surface of the floor covering is chemically or mechanically modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which it is applied." Shortland and Wallace, either alone or in combination, fail to disclose or suggest a chemically or mechanically modified lower surface of a floor covering to ensure that there is adequate grip between the lower surface and the floor to which it is applied. Therefore, claim 19 is patentable over the cited art for at least this additional reason.

CONCLUSION

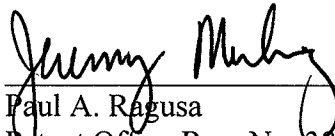
Entry of the foregoing amendments and remarks into the file of the above-identified application is respectfully requested. Applicant believes that claims 1-7, 9-15 and 17-19 are in condition for allowance. Withdrawal of all rejections and reconsideration of the amended claims is requested. An early allowance is earnestly sought.

Applicant believes that no additional fees are due in the timely filing of this response. In the event that fees are due, or overpayment is made, however, the Director is hereby authorized to charge payment of any such fees, or to credit any overpayment, to Deposit Account No. 02-4377.

If there are any remaining issues to be resolved, Applicant respectfully requests that the Examiner kindly contact the undersigned attorney for early resolution.

Respectfully submitted,

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